REMARKS

The title has been changed so it is consistent with the claimed subject matter.

Claim 1 has been amended to overcome the rejection based on 35 USC 112, ¶ 2, as being indefinite for failing to provide an antecedent basis for "said data device" in lines 12 and 13. In carefully reviewing the remaining claims, attorney for applicant noticed the same antecedent basis problem exists in each of independent claims 6, 14 and 15. Accordingly, each of claims 6, 14 and 15 has been amended to cure the antecedent basis problem with regard to "said data device". Each of independent claims 1, 6, 14 and 15 has also been amended for clarity. The wording "upon said operating system installed" now reads --upon said primary operating system being installed--. In addition, the clause "said plurality of partitions . . . being in a non-running static state" now reads --said plurality of portions . . . and while the primary operating system is in a non-running static state--. The foregoing requirements were set forth in the independent claims as previously submitted, but were in somewhat indefinite form, that has now been cured. Entry of the amendment is in order because it does not raise new issues or require a new search. The amendment was not previously made because attorney for applicant, upon reviewing the independent claims, realized the syntax was somewhat awkward.

Before considering the various rejections, attorney for applicant notes that the Examiner is apparently of the belief that many of the claimed features of the present invention are inherent in the primary reference, Chrabaszcz (US 6,138,179). Attorney for applicant has come to this conclusion because many portions of the Chrabaszcz reference cited by the Examiner do not appear to include the features the Examiner says these portions of the reference have.

The Examiner must remember that the decisions place a substantial burden on those who rely on inherency. The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. <u>In re Rijckaert</u>, 9 F3d 1531, 1534, 28 USPQ 1955, 1957 (Federal Circuit 1993); <u>In Re Oelrich</u>, 666 F2d 578, 58, 582, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is <u>necessarily</u> present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency

may not be established by probabilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Roberston, 169 F3d 743, 745, 49 USPQ 2nd 1949, 1950-1951 (Federal Circuit 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. Ex parte Levy, USPQ 2nd 1461, 1464 (Board of Patent Appeals and Interferences 1990). MPEP 2112.

Bearing the foregoing in mind, applicant traverses the rejection of claims 1, 3-8, 11-17, 19 and 20 as being anticipated by Chrabaszcz. Claim 1, upon which claims 2-5 depend, is directed to a method of manufacturing an operating system master template for installing at least one operating system onto a computer entity. Chrabaszcz has no disclosure of a method of manufacturing an operating system master template for installing at least one operating system. The Examiner relies on the abstract of Chrabaszcz for this feature. However, there is nothing in the Chrabaszcz abstract about making an operating system master template for installing at least one operating system onto a computer entity. The Chrabaszcz abstract is concerned with a system for automatically configuring and installing a pre-specified software program in a computer system. The configuring and installing system includes a partitioning module and a formatting module. There is not even mention of an operating system master template in the Chrabaszcz abstract, no less mention of a method of making such a master template. Consequently, the rejection of claim 1 as being anticipated by Chrabaszcz is incorrect because Chrabaszcz does not disclose every feature of claim 1.

Chrabaszcz also has no specific disclosure of installing a secondary operating system on a second partition of a data storage device. While column 3, lines 15-28 discusses installing an extended DOS partition, as indicated in the office action, there is no indication that the extended DOS partition qualifies as a second operating system. If the position of the Examiner is that the extended DOS partition is inherently a secondary operating system, the Examiner must provide reasoning or evidence to support such a position. See the previous discussion regarding the law of inherency. In addition the definition of "extended DOS partition" in column 3, line 23, as further defined in column 7, lines 2-5 seems to belie the Examiner's position regarding the extended DOS partition being a secondary operating system. Column 7, lines 2-5 indicate the

extended DOS partition provides "a core dump" memory in the event of a system failure. This definition of extended DOS memory seems to be inconsistent with the requirement of claim 1 for a secondary operating system.

The Office Action states that Chrabaszcz, in column 7, line 53-67, to column 8, lines 1-25, discloses installing the secondary operating system while the first partition of the data storage device is in a non-running state. The main segment of this portion of Chrabaszcz concerns the statement that, after the first reboot, the automatic configuration formatting and installation (ACFI) program recognizes that the partition step has already been performed and does not repeat these steps. The ACFI program then detects whether the computer is a dual disk installation and essentially "remembers" that these steps were performed prior to rebooting and does not perform them again. This "recall" is accomplished by temporarily writing information to the floppy disk including the ACFI program. The information is saved as a file prior to reboot. This file is read after the reboot and serves as a reminder to the program of where the program left off. Attorney for applicant is unable to see where this portion of Chrabaszcz discloses installing a secondary operating system while the primary operating system is in a non-running static state. The Examiner must provide rationale or evidence for his position that the quoted portion of Chrabaszcz discloses the foregoing step.

The anticipation rejection of claim 3 is improper for the same reasons advanced for claim 1, upon which claim 3 depends. In addition, column 7, lines 2-15 of Chrabaszcz does not appear to disclose a back-up application sub-component for installation of a back-up application onto a computer entity, as the Office Action alleges. Column 7, lines 2-15 is concerned with a "core dump" for the contents of a random access memory (RAM) prior to shut down associated with a system failure. The Examiner must provide reasoning or evidence for his position that the relied upon portion of Chrabaszcz inherently includes a RAM that stores a back-up application when there is a system failure.

Claims 4 and 5 are similar to each other, with the sole difference being that claim 4 relates to set-up data files for set-up of a primary operating system, while claim 5 is concerned with files for set-up of the secondary operating system. Chrabaszcz does not anticipate either claim 4 or claim 5 for the reasons discussed in connection with claim 1, upon which claims 4 and

5 depend. In addition, the portion of Chrabaszcz relied on by the Examiner for the features of claims 4 and 5, (i.e., column 8, lines 5-67 to column 9, lines 1-6) fails to include the requirements of claims 4 and 5, particularly with regard to deletion of the set-up of data files after a successful set-up of the primary operating system. The only somewhat relevant portion of Chrabaszcz that attorney for applicant could find appears in column 8, line 25 that says "this information is typically removed after the re-boot." From line 22, the information is about the "recall" of the steps performed prior to rebooting. However, attorney for applicant does not understand how the foregoing portion of Chrabaszcz discloses the requirement of claim 4 for deletion of set-up files for set-up of the primary operating system, or the claim 5 requirement for deletion of the set-up data files for set-up of the secondary operating system. The Examiner must provide evidence or reasoning to support his position with regard to the allegations regarding claims 4 and 5.

The allegation in the office action that claim 6 is another version of the method defined by claims 1, 4 and 5 is incorrect. Claims 1, 4 and 5 are directed to a method of making an operating system master template for installing at least one operating system onto a computer entity. In contrast, claim 6 is directed to a method of manufacturing a computer entity having at least a data processor and at least one data storage device. As a result, the method of claim 6 is more closely related to Chrabaszcz than the method of claim 1. However, the Examiner has failed to show that Chrabaszcz inherently includes the steps of (1) installing a secondary operating system onto a second partition of a data storage device, and (2) installing a secondary operating system while the primary operating system is in a non-running static state. Additionally, the Examiner has failed to provide proof that removal of the recall information, as discussed by Chrabaszcz in column 8, lines 24-25, is the same as the claim 6 requirement for deleting an installation component after the primary and secondary operating systems have been installed.

Dependent claims 7, 8, 11, 12 and 13 depend on claim 6 and are allowable therewith. In addition, claim 7 requires running a program to set-up license key data on a further partition on the data storage device. The Examiner says Chrabaszcz discloses this feature in column 9, lines 36-67 to column 10, lines 1-38. However, there is no specific mention of license key data in this portion of Chrabaszcz. The Examiner must provide scientific reasoning or evidence to support

his position that the stated portion of Chrabaszcz discloses the foregoing step of claim 7.

The Examiner relies on column 7, lines 2-15 of Chrabaszcz for the feature of claim 11 regarding installing the installation component by installing a back-up program installation component. However, this portion of Chrabaszcz is concerned with a core dump in the event of a system failure. The core dump involves storing the contents of RAM prior to shut down associated with system failures. While the RAM may store information related to the state of the operating system being installed, the Examiner has produced no reasoning or evidence to show the core dump is a back-up application sub-component for installation of a back-up application.

Claim 12 says the deleting step of claim 6 is performed by deleting a back-up program installation component after a successful installation of a back-up program onto the computer entity. The office action fails to provide any reasoning or evidence to show that column 8, lines 5-67 to column 9, lines 1-6 of Chrabaszcz inherently includes a deleting back-up program installation component after successful installation of a back-up program onto the computer entity. The Chrabaszcz reference merely states the information about the recall is removed after the re-boot. The Examiner has offered no proof or reasoning to show that information about the recall is the same as a back-up program installation component.

The Examiner has failed to show how Chrabaszcz, in column 7, lines 53-67 to column 8, lines 1-4, inherently includes system identification data that uniquely identifies a relationship between the operating system and the computer entity, as claim 13 requires. The stated portion of Chrabaszcz indicates that partitions are created using a set of prefabricated Master Boot Records (MBR), Boot Record (BR), and Extended Boot Record (EBR) files, which are contained on the floppy diskette. The MBR file contains information pertaining to the size of all the partitions and includes an index which contains the address of each partition. The BR contains similar information pertaining to the active DOS partition only and the EBR contains the information pertaining to the extended DOS partition. The Examiner has failed to provide evidence or reasoning as to why this information is system identification data that uniquely identifies a relationship between the operating system and the computer entity.

Claim 14 is a product by process claim that indicates a computer entity product is formed by the method of claim 6, as correctly stated in the office action. Claim 14 is allowable for the

same reasons advanced with regard to claim 6.

The allegation in the Office Action that independent method claim 15 is another version of the method discussed above in connection with claim 1 is wrong. Claim 1 is concerned with a method of manufacturing an operating system master template for installing at least one operating system onto a computer entity. In contrast, claim 15 is directed to producing a production version of an operating system for installation into a production version computer entity. Claim 15 requires an operating system master template to be created. Chrabaszcz has no disclosure of creating an operating system master template, as previously discussed. Further, Chrabaszcz does not disclose storing a secondary operating system on a partition of an operating system master template. Chrabaszcz also fails to disclose loading an operating system master template into a mastering computer entity to create a master disk image of the operating system master template on the mastering computer entity. Chrabaszcz also fails to disclose replicating a master disk image by loading the master disk image from the mastering computer entity onto a production computer entity. Attorney for applicant notes that the Examiner has not even attempted to identify any portion of Chrabaszcz that discloses the foregoing steps. In addition, the Examiner has failed to provide reasoning or evidence to show that Chrabaszcz discloses the step of installing a secondary operating system on a partition of a master disk only upon a primary operating system being installed and while the primary operating system is in a non-running static state as claim 15 requires and as discussed previously.

Claims 16, 17, 19 and 20, which depend on claim 15, are allowable with claim 15. In addition, claims 16, 17, 19 and 20 include limitations that the Examiner has not shown are included in Chrabaszcz. For example, claim 16 requires the replicated master disk image of claim 15 to be loaded onto a production computer entity, resulting in the installation of a secondary operating system onto a secondary partition of the production computer entity. There is no indication in the office action of Chrabaszcz including a replicated master disk image. There is no disclosure in Chrabaszcz of a master disk image operating to install a secondary operating system onto a partition of a production computer entity. Further, there is no disclosure in Chrabaszcz of a replicated master disk image loaded onto a production computer entity that operates to self-delete an installation component after a successful loading of the primary and secondary operating systems onto the production computer.

The Examiner has failed to provide sufficient information to show that Chrabaszcz includes the claim 17 limitation of an installation component including a back-up program installation component for installing a back-up program.

The Examiner has failed to provide reasoning or evidence that Chrabaszcz replicates a loaded master disk image, as claims 19 and 20 require. In Chrabaszcz, the automatic configuration formatting and installation program is on a floppy disk, see column 5, line 25. The floppy disk is presumably inserted into a floppy disk slot of a computer. In contrast, claim 15 requires loading a master disk image from a mastering computer entity onto a production computer entity.

Applicant traverses the rejection of claims 2, 9 and 18 as being obvious as a result of Chrabaszcz in view of Bearden (US 6,490,723). Bearden fails to cure the deficiencies noted with regard to claims 1, 6 and 15, upon which claims 2, 9 and 18 respectively depend. Consequently, claims 2, 19 and 18 are not rendered obvious by the combination of Chrabaszcz and Bearden.

Applicant traverses the rejection of claim 10 as being obvious as result of Chrabaszcz and Doran Jr. (US 6,385,766). Doran fails to cure the deficiency of claim 6, upon which claim 10 depends. Consequently, claim 10 is not rendered obvious by the combination of Chrabaszcz and Doran.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.